REMARKS

I. Introduction

This Amendment addresses the Office Action mailed April 28, 2009.

Claims 41-79 are currently pending. Claims 41-69 stand rejected. Claims 70-79 were subject to a restriction requirement and withdrawn from consideration by the Examiner. Claims 44, 46, 59, 64, and 73 were amended to correct informalities. No new matter was added.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

II. Election/Restriction Requirement

The Examiner restricted newly added claims 70-79 and withdrew them from consideration as being allegedly directed to a non-elected invention. Applicant respectfully disagrees and requests reconsideration. While the invention of claims 70-79 is admittedly in a different statutory category, i.e., an apparatus, this is not sufficient, by itself to justify a restriction requirement. Accordingly, reconsideration is respectfully requested.

III. Rejection of claims 42-69 under 35 U.S.C. 112, first paragraph

Claims 42-69 stand rejected under 35 U.S.C. 112, first paragraph. Applicant respectfully disagrees with the rejection and requests reconsideration. As an initial matter, Applicant notes that claim 41 was not rejected, and it appears the Office found the objected to features acceptable in claim 41. Second, the burden is on the Examiner to show the Written Description requirement has not been met. MPEP 2163.04. The Examiner must provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. MPEP 2163.04(I).

Applicant notes that the claimed terminal and scanner are supported in at least paragraph 14 of the originally filed specification. The terminal is configured to carry out the claimed methods, including the scanning of the random request regions, is described at least in paragraph 17, and paragraphs 20 -22. Therefore, Applicant respectfully submits that the

added claim language is described in the original specification and drawings and , accordingly, requests withdrawal of the Section 112 rejection.

IV.   Rejection of Claims 41-46, 48-58, 62, 63, 65, and 69 under 35 U.S.C. § 103(a)

Claims 41-46, 48-58, 62, 63, 65, and 69 stand rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,249,801 ("Jarvis"), in view of U.S. Patent No. 5,239,165 ("Novak") and in further view of U.S. Patent 6,602,138 ("Nulph"). Although Applicant disagrees with the rejection, independent claims 41 and 54 are amended herein. The present claims are patentable over the proposed combination of Jarvis and Novak for at least the following reasons.

As an initial matter, to the extent that any portion of the Office Action may be construed to take Official Notice of a fact, or otherwise suggest that an element of any claim is "well known" or "common knowledge," without citing to a specific reference, Applicant respectfully traverses such assertions and expressly reserves the right to appeal any rejection made based on statements that have been made without an affidavit of the Examiner or proper citation of a reference.

As an introduction, some example embodiments of the present invention provide for systems and methods of processing gaming entry slips which may enable a plurality of computer-generated picks to be requested from a single random request region of the slip. In example embodiments, each gaming slip may include a plurality of random request regions, where each random request region corresponds to a different type of game. As a result, several advantages may be achieved such as greater sales per slip, faster transaction speeds, increased cross-marketing opportunities, reduced waste of consumable, opportunities for larger sales per transaction, and improved game type tracking.

Example embodiments of the present invention, therefore, address deficiencies in traditional gaming slips. For example, a conventional gaming slip might include a substrate such as paper or cardboard with gaming information printed on the substrate, where the gaming information has one or more game panels for the selection and/or identification of picks. In one approach, each game panel includes a manual selection region that enables a manual pick to be identified and a random request region that enables a computer-generated pick to be requested. A manual pick is typically one or more manually-selected numbers where a computer-generated pick is typically one or more randomly-selected numbers. One particular concern associated with such an approach is that it has been determined that a substantial number of gaming slips are submitted with only one of the game panel manual

selection regions completed. Thus, the typical gaming slip has a considerable number of unused manual selection regions, which effectively results in waste and added costs for the overall system. On the other hand, it has been determined that many gaming slips are submitted with multiple game panel random request regions filled out to request computer-generated picks. Merely eliminating game panels to reduce the waste associated with unused manual selection regions would therefore result in lost revenue under conventional approaches because the random request regions would also be eliminated along with the extra entry purchases they induce. Example embodiments of the present invention may address the deficiencies of such conventional gaming slips.

Accordingly, independent claim 1, as currently amended, recites:

41. A method of processing a gaming entry slip, comprising:
reading, at a lottery terminal including a scanner, a random request region corresponding to a single game from the gaming slip, the random request region configured to be read by the scanner **and having a player's written mark made with a writing instrument**, the written mark indicating the player's request for a plurality of randomly generated picks in the single game; and
responsive to reading the random request region, generating the requested plurality of randomly generated picks for the single game, each pick including a plurality of randomly-generated numbers, **the quantity of picks generated for the single game being determined based on information read from the random request region and indicated by the player's written mark**.

The proposed combination of Jarvis and Novak and Nulph does not teach or suggest each of the elements of claim 41 as highlighted above. For example, claim 41 recites "responsive to reading the random request region, generating, at the terminal, the requested plurality of randomly generated picks for the single game, each pick including a plurality of randomly-generated numbers, **the quantity** of picks generated for the single game being **determined based on information read from the random request region and indicated by the player's written mark**."

The previous Office Action response explained why Jarvis in view of Novak does not teach or suggest the highlighted features. Jarvis contemplates a play slip including a region allowing a player to request **exactly one** "easy pick." In order to select a second "easy pick" a second region must be marked. Thus, nothing in Jarvis teaches or suggests that "**the quantity** of picks generated for the single game **being determined based on information read from the random request region and indicated by the player's written mark**," as recited in claim 41. In fact, Jarvis presents exactly the type of playslip which the present

invention seeks to avoid and improve upon. Because the playslip in Jarvis does not allow an indication of quantity but requires one individual "easy pick" area to be marked for each "easy pick" requested, the playslips contemplated by Jarvis are inefficient. For example, addressing the example playslip found in Fig. 1 of Jarvis, should a player using such a playslip desire six "easy picks," the player would be forced to use an additional playslip, wasting that playslip. Jarvis also is not scalable, as the number of picks that can be obtained is limited by the size of the entry slip. In contrast, Applicant's claimed invention can scale in an almost unlimited fashion.

Novak also fails in exactly the same manner as Jarvis. For example, Fig. 4 of Novak appears to illustrate a playslip, on which two "quick picks" have been chosen. In order to select two "quick picks," however, the playslip is marked twice (the two elements labeled 64). Thus, Novak also does not teach or suggest that **"the quantity** of picks generated for the single game **being determined based on information read from the random request region and indicated by the player's written mark**," as recited in claim 41. In addition, the playslip of Novak is subject to similar inefficiency as the playslip described in Jarvis. By way of illustration, if the player responsible for the playslip illustrated in Fig. 4 desired several additional "quick picks," an additional playslip would be required, as each single "quick pick" is represented by an individual entry.

The present Office Action admits that Jarvis in view of Novak does not teach or suggest all of the features of claim 1 and therefore presents a proposed combination with Nulph. In particular, the Office Action says "Nulph discloses in Figure 4, line 25-65 one such example." This citation is confusing and not understood. If Nulph **Col.** 4:25-65 is meant, it is not seen how Nulph teaches or suggests the **quantity** of picks generated for a single game being determined based on information read from a random request region and indicated by a player's written mark made with a writing instrument. Similarly, Nulph **Fig.** 4 does not appear to teach or suggest this feature. While Nulph generally describes using handwritten marks to indicate numerical entries, there is not discussion of using scanned a handwritten entry to indicate the number of quick picks desired for a game. In fact, Nulph appears to be completely silent as to quick picks or multiple quick picks.

Accordingly, for at least the reasons presented above, it is respectfully submitted that the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of claim 41. In addition, Applicant continues to assert that the proposed combination is improper, reasserting the arguments presented in Applicant's previous responses.

Similarly, independent claims 54, as currently presented, recites:

A gaming slip, comprising:
a substrate; and
gaming information coupled to the substrate, the gaming information including a random request region having a marking area corresponding to a single game and configured to be read by a lottery terminal equipped with a scanner,
wherein the random request region corresponding to the single game is configured to enable a player to request a plurality of computer generated picks for the single game by writing in the marking area with a writing instrument,
and **wherein the random request region corresponding to the single game is configured so that the quantity of computer-generated picks for the single game is indicated by the writing made in the marking area by the player with the writing instrument**.

Similar to claim 41, claim 54 recites that "the random request region corresponding to the single game is configured so that **the quantity** of computer-generated picks for the single game **is indicated by the writing made in the marking area** by the player with the writing instrument." Accordingly, it is respectfully submitted that the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of claim 54 for at least reasons similar to those present above in connection with claim 41. The proposed addition of Nulph does not correct the deficiencies of the proposed combination of Jarvis and Novak.

Therefore, for at least the reasons presented above, it is respectfully submitted that claims 41 and 54 are patentable over the proposed combination of Jarvis and Novak. In addition claims 42-46, 48-53, 55-58, 62, 63, 65, and 69 depend from claims 41 and 54, and it is respectfully submitted that the dependent claims are patentable over the proposed combination of references for at least the same reasons as the claims from which they depend. Withdrawal of the rejection is respectfully requested.

V. **Rejection of Claims 47, 66, and 67 under 35 U.S.C. § 103(a)**

Claims 47, 66, and 67 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Jarvis and Novak, in view of U.S. Patent No. 5,110,129 ("Alvarez") and in further view of Nulph. Claims 47, 66, 67 are patentable over the proposed combination of Jarvis, Novak, and Alvarez for at least the reasons presented below.

Claim 47 depends from claims 41 and claims 66 and 67 depend from claim 54. As explained above, the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of independent claims 41 and 54, as presented. The Office Action does not suggest that Alvarez or Nulph teach or suggest the elements of claims 41 or 54 not taught or suggested by the primary references, and it is respectfully submitted that Alvarez does not

teach or suggest those elements. Accordingly, it is respectfully submitted that independent claims 41 and 54 are patentable over the proposed combination of Jarvis, Novak, Nulph and Alvarez, as are dependent claims 47, 66, and 67. Withdrawal of the rejection is respectfully requested.

VI.   Rejection of Claims 59-61 and 64 under 35 U.S.C. § 103(a)

Claims 59-61 and 64 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Jarvis and Novak, in view of U.S. Patent No. 5,979,894 ("Alexoff") and in further view of Nulph. Claims 59-61 and 64 are patentable over the proposed combination of Jarvis, Novak, and Alexoff for at least the reasons presented below.

Claims 59-61 and 64 depend from claim 54. As explained above, the proposed combination of Jarvis and Novak does not teach or suggest each of the elements of independent claim 54, as presented. It is possible that the Office Action implies that Alexoff addresses the deficiencies of the primary references as to independent claims 41 and 54. For example, the Office Action states that "Alexoff discloses in Figure 4 a gaming slip with a 'Number of Plays' section at the bottom, where the player selected the number of picks to be plays by marking one box." Office Action at 4. Alexoff, however, does not cure the deficiencies of the primary references. Although it is true that Figure 4 illustrates an area labeled "number of plays," it is clear that the area does not represent a quantity of randomly generated picks. Rather, the same Figure also illustrates exactly the same kind of traditional request mechanism generally described in Jarvis and Novak, i.e., each section includes an area which allows for the request of a single "Quick Pick." While it is not entirely clear what the "Number of Plays" section may be (it is noted that Alexoff makes no reference to the section at all), by providing a mechanism for selecting "Quick Picks," Alexoff itself makes clear that the "Number of Plays" section does not refer to a quantity of randomly generated picks requested. Accordingly, it is respectfully submitted that independent claims 41 and 54 are patentable over the proposed combination of Jarvis, Novak, Nulph and Alexoff for at least the reasons presented above, as are each of their dependent claims, including claims 59-61 and 64. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. While no additional fee is considered to be due, the Office is hereby authorized to charge any fees, which may arise out of the filing of this paper, or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to the deposit account of **K&L Gates LLP,** Deposit Account No. **0080570**.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any matter concerning this application.

Respectfully submitted,

Dated: ___Oct. 28, 2009____   By: _/Andrew L. Reibman/_____
                                    Andrew L. Reibman
                                    Reg. No. 47,893
                                    K&L Gates LLP
                                    599 Lexington Avenue
                                    New York, N.Y. 10022
                                    (212) 536-3900 (telephone)
                                    (212) 536-3901 (facsimile)
                                    CUSTOMER NO. 00545

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